

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEN HIRUNUMA AND ATSUMI KANEKO

Appeal 2007-0016
Application 10/700,496
Technology Center 2800

Decided: January 31, 2007

Before JOSEPH F. RUGGIERO, MAHSID D. SAADAT, and
JEAN R. HOMERE, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-7, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

INTRODUCTION

The claims are directed to a binocular structure which incorporates a digital camera for capturing an image of an object viewed through optical system of the binoculars. The binocular structure further includes a microphone which is positioned on the bottom face of the binoculars.

Claim 1 is illustrative:

1. Digital-camera-provided binoculars, comprising:

a digital camera that is able to capture an image of an object which is observed through optical systems of said binoculars; and

a microphone;

wherein said microphone is provided on a bottom face of said binoculars.

The Examiner relies on the following prior art:

| | | |
|----------|--------------------|--|
| Hirunuma | US 2003/0063189 A1 | Apr. 03, 2003 |
| Wu | US 2005/0018048 A1 | Jan. 27, 2005 (filed Aug. 14, 2001) |
| Nagumo | JP 08-098209 | Dec. 04, 1996 |

Claims 1 and 3-6 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Wu. Claims 2 and 7 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Wu in view of Hirunuma with respect to claim 2, and Wu in view of Nagumo with respect to claim 7.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for their respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the disclosure of Wu fully meets the invention as recited in claims 1 and 3-6. In addition, with respect to the Examiner's obviousness rejection, we are of the opinion that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in appealed claim 2. We reach the opposite

¹ The Appeal Brief was filed March 13, 2006. In response to the Examiner's Answer mailed April 14, 2006, a Reply Brief was filed June 12, 2006 which was acknowledged and entered by the Examiner as indicated in the communication mailed June 26, 2006.

conclusion with respect to the Examiner's obviousness rejection of claim 7.

Accordingly, we affirm-in-part.

We consider first the Examiner's 35 U.S.C. § 102(e) rejection of claims 1 and 3-6 based on Wu. At the outset, we note that it is well settled that anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

With respect to independent claim 1, the Examiner indicates (Answer 4-5) how the various limitations are read on the disclosure of Wu. In particular, the Examiner directs attention to the illustration in Figure 1 of Wu as well as the disclosure at paragraphs [0019] and [0022 of Wu].

In our view, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a *prima facie* case of anticipation. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner's *prima facie* case. Only those arguments actually made by

Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)].

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Wu so as to establish a case of anticipation. In particular, Appellants' arguments (Br. 10-12; Reply Br. 2-4) focus on the contention that, in contrast to the claimed invention, the microphone in Wu is not provided on the bottom face of the binoculars.

After reviewing the Wu reference in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in the Answer. We find to be persuasive the Examiner's assertion (Answer 4, 6-7) that the user's preference in how to hold the binoculars in Wu will determine whether the microphone is on the top surface or bottom surface. For example, as suggested by the Examiner, if the user chooses to hold the binoculars so that the control buttons 22 and 23 are operated with the thumb rather than the index finger then the microphone would be on the bottom surface of the binocular structure (with reference to the illustration in Wu's Figure 1). In our view, this is a reasonable interpretation of the disclosure of

Wu and satisfies the requirements of independent claim 1 especially in view of the fact that the claim language “bottom surface” is not related to any other surface or structure of the claimed binocular.

Further evidence of the reasonableness of the Examiner’s interpretation of Wu is that the disclosure of Wu scrupulously avoids referring to any surface as a top or bottom surface. For example, instead of describing the illustration in Figure 1 as a top or bottom view, Wu merely describes it as a perspective view [0006].

We further find to be unpersuasive Appellants’ argument (Br. 11; Reply Br. 4) that Wu completely fails to disclose the location of the microphone in relation to the binoculars. Contrary to Appellants’ contention, Wu does indeed disclose the location of the microphone, i.e., inside the digital image storage unit 2 which is located on what is, in our view, reasonably interpreted by the Examiner as being the bottom surface of the binoculars.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Wu, the Examiner’s 35 U.S.C. § 102(e) rejection of independent claim 1 is sustained.

We also sustain the Examiner’s 35 U.S.C. § 102(e) rejection of dependent claims 3-6 based on Wu. We find no persuasive arguments from

Appellants that convinces us of any error in the Examiner's finding that, with respect to claim 3, Wu discloses [0004] that microphone recorded sound is associated with a digital camera captured image. Similarly, with respect to dependent claim 4, we agree with the Examiner that Wu discloses [0013 and 0018-0023] that the microphone sound recording operation is performed just after the image capturing operation. We further agree with the Examiner that, as illustrated in Wu's Figure 1, Wu discloses that the microphone is positioned on the bottom face near the rear face location of the ocular lens (appealed claim 5) and between a pair of optical systems of the binoculars (appealed claim 6).

We next consider the Examiner's 35 U.S.C. § 103(a) rejection of claim 2 in which the Hirunuma reference is added to Wu to address the claimed tripod attaching section feature. We sustain this rejection as well. Since we agree with the Examiner, as previously discussed, that the Wu reference can be reasonably interpreted as providing a microphone on the bottom face of the binoculars, we find no error in the Examiner's finding of obviousness to the skilled artisan of attaching a tripod to the bottom face of the binoculars to reduce hand vibrations as taught by Hirunuma.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection, based on the combination of Wu and Nagumo, of dependent claim

7, we note that, while we found Appellants' arguments to be unpersuasive with the respect to the Examiner's obviousness rejection of dependent claim 2, we reach the opposite conclusion with respect to the rejection of claim 7. In addressing the language of claim 7 which requires that the camera and microphone are mounted on different surfaces of the binoculars, the Examiner has added the teachings of Nagumo to Wu. According to the Examiner (Answer 7), the cameras in Wu are designated by the reference numerals 2a and 2b and, as illustrated in Nagumo's Figure 1A, are located on a different binocular surface from the microphone.

Our interpretation of the disclosure of Nagumo, however, coincides with that of Appellants, i.e., contrary to the Examiner's contention, the cameras are designated by reference numerals 1a and 1b in Nagumo and, as illustrated in Nagumo's Figure 1, are located on the same surface as the microphone (5a, 5b). We find no basis for the Examiner's finding that the cameras in Nagumo are the illustrated elements 2a and 2b which are unambiguously identified by Nagumo as the camera controllers and not the cameras. We further find ourselves constrained to agree with Appellants' interpretation of Nagumo's disclosure since the Examiner has not responded to Appellants' arguments with respect to the rejection of claim 7.

CONCLUSION

In summary, we have sustained the Examiners 35 U.S.C. § 102(e) rejection of claims 1 and 3-6. With respect to the Examiner's 35 U.S.C. § 103(a) rejection, we have sustained the rejection of claim 2, but have not sustained the rejection of claim 7. Accordingly, the Examiner's decision rejecting appealed claims 1-7 is affirmed-in-part.

Appeal 2007-0016
Application 10/700,496

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(effective September 13, 2004).

AFFIRMED-IN-PART

kis/ce

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